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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,089	06/20/2005	Munetake Ebihara	09812.0753-00000	4198
22852 7590 02/26/2008 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER MIZRAHI, DIANE D	
			ART UNIT 2165	PAPER NUMBER
			MAIL DATE 02/26/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/510,089

Applicant(s)

EBIHARA ET AL.

Examiner

Diane Mizrahi

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 20-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10-4-04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

DIANE MIZRAHI  
PRIMARY EXAMINER

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This is in response to the *DECISION ON PETITION TO WITHDRAW FINALITY OF OFFICE ACTION UNDER 37 CFR § 1.181 AND WITHDRAW RESTRICTION REQUIREMENT UNDER 37 CFR §1.144* which has been granted.

This is a Final Office Action in response to the Applicant's amendment filed 01/12/2007. Claims 1-19 have been canceled. Newly added claims 20-36 are pending, claims 20, 26, 30 and 36 are independent claims.

#### **Claim Rejections - 35 USC 101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 20-29 and 36 are rejected under 35 U.S.C. 101 because the claims are directed to a non-statutory subject matter, specifically, the claims are not directed towards the final result that is "useful, tangible and concrete.

See State Street, 149 F.3d at 1373-74 USPQ2d at 1601-02 and Alappat, 33 F.3d at 1544, 31 USPQ2d at 1557). The decisions state to be eligible for patent protection, the claimed invention as a whole must accomplish a practical application. A claim limited to a machine or manufacture, which has a practical application, is statutory. Alappat, 33 F.3d at 1544, 31 USPQ2d at 1557). That is, it must produce a "useful, concrete and tangible result". The

purpose of this requirement is to limit patent protection to inventions that possess a certain level of “real world” value as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96 (1966); In re Fisher, 421 F.3d 1365, 76 USPQ 2d 1255 (Fed. Cir. 2005); In re Ziegler, 992 F.2d 1197, 1200-03, 26 USPQ 2d 1600, 1603-06(Fed. Cir.1993).

Claims 26-29 and 36 are rejected under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter. As noted below, claim 38 is directed to neither a “process” nor an “apparatus,” but rather embrace and overlap two different statutory classes of invention set forth in 35 U.S.C. 101, which is drafted so as to set requirements for the statutory classes of invention in the alternative only. See, Ex Parte Lyell, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990). See also, MPEP 2173.05(p).

Independent Claims 9 and 36 recite a “*computer program*” having a “*medium*” and comprising “*code*” for performing various functions. Nothing in the disclosure of the present invention indicates that the recited “*computer program*” and/or the recited “*medium*” necessarily includes hardware. Thus, for purposes of examination, the examiner will assume that the recited “*computer program*” and the recited “*medium*” comprise only computer software. Accordingly, the “*computer program*” recited in Claims 9 and 36 is software *per se*.

Computer software is not a process, a machine, a manufacture or a composition of matter. Accordingly, Claims 9 and 36 fails to recite statutory subject matter, as defined in 35 U.S.C. 101.

Claims dependent claims 27-29 merely recite additional code. Accordingly, Claims 27-29 fail to recite statutory subject matter, as defined in 35 U.S.C. 101.

Examiner recommends that to satisfy the 101 rejection, and to be “useful”, the claim must satisfy the utility requirement thus the invention has to be specific, substantial and credible. (MPEP 2107 and In re Fisher, 421 F.3d 1365, 76 USPQ 2d 1255 (Fed. Cir. 2005); the claims must produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77; and that the result that can be substantially repeatable or must substantially produce the same result again. In re Swartz, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000).

Examiner recommends Applicant to amend the claims without adding any new matter to the originally filed specification.

In the interest of compact prosecution, the application is further examined against the prior art, as stated below, upon the assumption that the applicants may overcome the above stated rejections under 35 U.S.C. 101.

### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 20-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Asano et al. (US Publication No. 20050228809 and Asano hereinafter).

Regarding Claim 20, Asano teaches an information processing apparatus for granting access to content, comprising: a storage unit for storing an attribute information list (i.e. type definition list [0384], the attribute information list identifying a type of information processing apparatus and identifying a function of the information processing apparatus (i.e. one or more category entities corresponding to one or more category tree identification data selected on the basis of the EKB type definition list) [0022]; and an interpretation module (i.e. function) [0060] for determining whether the type and the function included in the attribute information list matches data contained in a property selection list distributed with the content (i.e. information processing system according to the present invention, the EKB type definition list can be held or accessed by an EKB requester that requests the key distribution center (KDC) to produce an EKB; and the EKB requester selects an EKB type identifier on the basis of the EKB type definition list) [0021] (i.e. EKB requester selects an EKB type identifier on the basis of the EKB type definition list and outputs an EKB production request including the selected EKB type identifier)[0046], wherein when the type and the function match the data, the information processing apparatus grants access to the content (i.e. gives permission of the registration)[0342], and when the type and the function do not match the data, the information processing apparatus denies access to the content [0342].

Regarding Claim 21, Asano teaches wherein the property selection list includes a parameter, and the interpretation module determines whether to grant access to the content based on the parameter [0342].

Regarding Claim 22, Asano teaches wherein the attribute information list is set on a per library unit basis with a library unit as a category (i. e. collection of a plurality of devices [0046] corresponding to a usage of the content (i.e. usage to specific users is to encrypt a content. More specifically, a content such as audio data, video data)[0007] , and the interpretation module determines whether to grant access to the content based on the attribute information list using the per library unit basis (i.e. gives permission of the registration ) [0342].

Regarding Claim 23, Asano teaches wherein the attribute information list further includes at least one of text data, code data, and numerical data, and the interpretation module (i.e. information indicating an EKB type identification number to be changed in the EKB type definition list, information indicating a category associated with that EKB type identification number, and information indicating what has occurred, for example, indicating that revocation) [0422] determines whether to grant access to the content by determining whether the text data, code data, or numerical data matches the data contained in the property selection list (i.e. decrypting the encrypted data can be obtained from a password or the like [0023].

Regarding Claim 24, Asano teaches acquiring a content key when the information processing apparatus grants access to the content (i.e. gives permission of the registration ) [0342]), wherein the content key decrypts the content [0023].

Regarding Claim 25, Asano teaches wherein the information processing apparatus receives a device node key (0301), and acquiring of the content key comprises decrypting an enabling block key based on the device node key (i.e. key node) (0159) (0301).

Regarding Claim 26, Asano teaches storing a property selection list, the property selection list identifying a first type of information [0384]processing apparatus and identifying a first function of the information processing apparatus [0022]; determining whether the first type and the first function match a second type and a second function of an information [0391]processing apparatus that requests the content[0177]; granting access to the content when the first type and the first function match the second type and the second function; and denying access to the content when the first type and the first function do not match the second type and the second function [0342].

Regarding Claim 27, Asano teaches wherein the property selection list further comprises a parameter [0177].

Regarding Claim 28, Asano teaches comprising dividing the property selection list into categories depending on the usage [0007] of the content (i.e. divided parts of the message are denoted by M1, M2, . . . , MN) ([0217].

Regarding 30, Asano teaches acquiring a property selection list, the property selection list identifying a first type of information processing apparatus and identifying a first function of the information processing apparatus[0384]; acquiring an attribute information list, the attribute information list identifying a second type of information processing apparatus and identifying a second function of the information processing apparatus[0022]; comparing the property selection list to the attribute information list to determine whether to grant access to the content[0021];



granting access to the content when the first type and the first function match the second type and the second function[0342]; and denying access to the content when the first type and the first function do not match the second type and the second function[0342].

Regarding 31, Asano teaches wherein the property selection list includes a parameter [0384], and the comparison determines whether to grant access to the content based on the parameter [0021].

Regarding Claim 32, Asano teaches wherein the attribute information list is set on a per library unit basis with a library unit as a category corresponding to a usage of the content [0046], and the comparison determines whether to grant access to the content based on the attribute information list using the per library unit basis [0342].

Regarding Claim 33, Asano teaches wherein the attribute information list further includes at least one of text data, code data, and numerical data, and the comparison [0023][0422] determines whether to grant access to the content by determining whether the text data, code data, or numerical data matches the data contained in the property selection list [0422].

Regarding Claim 34, Asano teaches acquiring a content key when access is granted to the content, wherein the content key decrypts the content [0159][0301].

Regarding Claim 35, Asano teaches receiving a device node key [0301], and acquiring the content key by decrypting an enabling block key based on the device node key[0030].

Regarding Claim 36, Asano teaches granting access to content [0021], the method comprising: acquiring a property selection list, the property selection list identifying [0021]a first type of information processing apparatus and identifying a first function of the information

processing apparatus [0342]; acquiring an attribute information list [0022], the attribute information list identifying a second type of information processing apparatus [0384] and identifying a second function of the information processing apparatus; comparing the property selection list to the attribute information list[0022]; granting access to the content when the first type and the first function match the second type and the second function[0342]; and denying access to the content when the first type and the first function do not match the second type and the second function[0342].

**Claim Rejections - 35 USC 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 29 is are rejected under 35 U.S.C. 103(a) as being unpatentable over Asano et al. (US Publication No. 20050228809 and Asano hereinafter) in view of Scott Cottrille et al. (U.S. Publication No. 2004003139 and Cottrille hereinafter).

The teachings of Asano have been discussed above.

Regarding Claim 29, Asano teaches property selection list [0384].

Asano does not extended markup language data.

Cottrille teaches extended markup language data (i.e. xml) [0140].

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Asano with the teachings of Cottrille to include the claimed, "markup language data" with the motivation to improve for content owner may wish to provide the user with the flexibility to purchase different types of use licenses at different license fees, while at the same time holding the user to the terms of whatever type of license is in fact purchased)(Cottrille, [0005])

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. U.S. patents and U.S. patent application publications will not be supplied with Office

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Art Unit: 2165

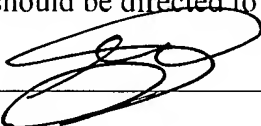
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actions. Examiners advises the Applicant that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)), from the Office of Public Records and from commercial sources. For the use of the Office's PAIR system, Applicants may refer to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane D. Mizrahi whose telephone number is 571-272-4079. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272-4146. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and (703) 305-3900 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

  
\_\_\_\_\_  
Diane Mizrahi  
*Diane.Mizrahi@USPTO.gov*  
Primary Patent Examiner  
Technology Center 2100

December 27, 2007